

Atty Dkt No.: 1998P07977US03
Serial No.: 09/218,783

REMARKS

Claims 1 – 27 remain in the application and stand finally rejected. This Amendment is being filed with a request for a one month extension of time and the appropriate fee. The Commissioner is hereby further authorized to charge any additional fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claims 1 – 27 are finally rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,229,888 to Miloslavsky. The rejection is respectfully traversed.

In responding to the assertion in the remarks of the amendment filed July 15, 2005, (“that Miloslavsky says nothing about what happens if the routed call goes unanswered, if the designated line is busy, or if the agent has set the do-not-call feature for the station”) since neither “a designated busy line, nor the setting of a do-not-call feature is recited in the claims, [the Office action] only address[es] the limitation of an unanswered call.” Office Action ¶ 12. Accordingly, these unaddressed differences between Miloslavsky and the present invention are deemed admitted. Further, in addressing only the latter difference, it is asserted in the Office Action that at “col. 4 lines 24-30, Miloslavsky teaches a system that is able to adapt to handle failures (e.g. traffic, busy signals, no answer) within a group pickup system. Miloslavsky further teaches a network failure, which may include a vacant number (e.g. whether an agent is available or active) (See col. 5 lines 12-19 and col. 5 lines 54-67).” *Id.* Similarly, in responding to the fact presented in the amendment filed July 15, 2005, “that Miloslavsky fails to teach or suggest, a system or method, where members pickup calls routed to an identified best available agent,” it is asserted that, “an identified best available agent is not recited in the claims. Therefore, Examiner will not address this limitation.” *Id.* Accordingly, this unaddressed difference between Miloslavsky and the present invention is deemed admitted.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.”

Atty Dkt No.: 1998P07977US03
Serial No.: 09/218,783

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). MPEP 2131. So, although a reference may use a different term for an element recited in the claimed invention, at the very least, to form a basis for anticipation, a person of ordinary skill in the art must be able to use the teaching of the cited reference to carry out the invention.

The MPEP, in §2183 entitled, "Making a *Prima Facie* Case of Equivalence," provides in pertinent part that

If the examiner finds that a prior art element
(A) performs the function specified in the claim

...

the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are:

(A) the prior art element **performs the identical function** specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification...

(C) there are **insubstantial differences** between the prior art element and the corresponding element disclosed in the specification...

(D) the prior art element is a **structural equivalent** of the corresponding element disclosed in the specification. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). That is, the prior art element **performs the function** specified in the claim in **substantially the same manner** as the function is performed by the corresponding element described in the specification

... examiners should also demonstrate, where appropriate, why it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute applicant's described structure, material, or acts for that described in the prior art reference. See *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner **until applicant disagrees with the examiner's conclusion, and provides reasons** why the prior art element should not be considered an equivalent...; and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (a case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103). (Emphasis added.)

Atty Dkt No.: 1998P07977US03
Serial No.: 09/218,783

Furthermore §2184 of the MPEP entitled, "Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a *Prima Facie* Case Is Made," provides in pertinent part that "[a]mong the indicia that will support a conclusion that one element is or is not an equivalent of another are: ... (A) Whether the prior art element **performs the identical function** specified in the claim in **substantially the same way**, and produces **substantially the same results** as the corresponding element disclosed in the specification." (Emphasis added.) There is nothing in this requirement to further require that those results be recited in the claims.

Thus, to establish that Miloslavsky is equivalent to a preferred embodiment group pick up system and method as the final Office action asserts, Miloslavsky must: respond substantially the same to unanswered calls, calls to a designated line that is busy, or to a designated line with the do-not-call feature set for the station (*See, e.g., specification* page 12, line 23 – page 13, line 5 with reference to Figure 6); and teach a system or method, where members pickup calls routed to an identified best available agent, *i.e.*, Miloslavsky must perform **"the identical function** specified in the claim[s] in **substantially the same way**, and [produce] **substantially the same results**" within the meaning of the present application. Thus, regardless of whether Miloslavsky responds substantially identically to an unanswered call as a preferred embodiment group pick up system and method (which the applicants maintain Miloslavsky does not), since it is admitted that Miloslavsky does not respond substantially the same to calls to a designated line that is busy, or to a designated line with the do-not-call feature set for the station and does not "teach or suggest, a system or method, where members pickup calls routed to an identified best available agent;" Miloslavsky does not perform **"the identical function** specified in the claim[s] in **substantially the same way**, and [produce] **substantially the same results**." Therefore, the applicants have met the burden in overcoming the allegation of *prima facie* anticipation based on the alleged equivalency of Miloslavsky with the group pick up system and method recited in claims 1 – 27. Reconsideration and withdrawal of the final rejection of claims 1 – 27 over Miloslavsky under 35 U.S.C. §102(e) is respectfully solicited.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth

Atty Dkt No.: 1998P07977US03
Serial No.: 09/218,783

above, the applicants respectfully request that the Examiner reconsider and withdraw the final rejection of claims 1 - 27 under 35 U.S.C. §102(e) and allow the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

January 23, 2006
(Date)

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830
(732) 321-3013

Francis G. Montgomery
Francis G. Montgomery
Reg. No. 41,202